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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,706	06/21/1999	SUMIYO OKADA	21.1924/JRB	7969

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STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

115

Office Action Summary

Application No.

09/336,706

Applicant(s)

OKADA, SUMIYO ET. AL.

Examiner

B. PRIETO

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-3, drawn to an information exchange system for transmitting, receiving and displaying messages in a time series basis at user terminals, classified in class 709, subclass 206.

II. Claims 4-5, drawn to a storage medium having a program recorded thereon for executing an information exchange on a plurality of networks, the program to be executed by a computer verifying a user terminal is connected to a network to transmit and/or receive the messages through the network and assuring recordation thereon, classified in class 455, subclass 412.

III. Claim 6-8 and 10, drawn to an information exchange system including user terminals connected via a plurality of networks, enabling communication between the terminals, for transmitting and receiving messages to/from terminals on a real-time basis to an area independent of a display area for each network, operated concurrently with the first unit, classified in class 709, subclass 227.

IV. Claims 9 and 11-12, drawn to an information exchange system for transmitting, receiving and displaying messages at user terminals when the message displayed is identified for message transmission, to one of the networks to which the identified message is transmitted, classified in class 379, subclass 93.01.

The inventions are distinct, each from the other because of the following reasons: Inventions I - IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP §806.05(d).

In the instant case, Invention I has a separate utility, usable in an information exchange system for transmitting, receiving and displaying messages in a time series basis at user terminals, lacking the following features:

(b) verifying a user terminal is connected to a network to transmit and/or receive the messages through the network and assuring recordation thereon, the program in the storage medium; (c) executing connection of the user terminal on a plurality of networks for common message exchange and displaying the message transmitted and/or received for each of the plurality of networks, **required for invention II;**

(f) a first unit transmitting and receiving messages to/from terminals on a real-time basis; (g) a display unit, displaying the messages transmitted and received to an area independent of a display area for each network, operated concurrently with the first unit; (h) a first memory storing an operation condition; (i) a request receiving unit executing processes based on transmitted requests; and a request notifying unit transferring the message received; (j) a cooperation request transmitting unit transmitting and receiving setting information required for operating the first unit and the display unit concurrently; (k) a notified message receiving unit receiving a message transmitted from the notifying unit and displaying the message on a display; (l) a message transmission unit operating with the first unit when a user responds to a message including the contents of the message displayed on the message display unit; and (m) a second memory storing validating a cooperation flag in the setting information, when a cooperation request is transmitted from the message display unit, **required for invention III;**

(n) transmitting and receiving messages to/from terminals on a real-time basis; and (o) identifying one of the messages, when the message is displayed, identified for message transmission, to one of the networks to which the identified message is transmitted, **required for invention IV;**

Invention II has a separate utility, usable for executing an information exchange on a plurality of networks by a program recorded on a storage medium, the program to be executed by a computer verifying a user terminal is connected to a network to transmit and/or receive the messages through the network and assuring recordation thereon, lacking the following features: (f) through (m) features discussed above,

required for invention III; (n) and (o) features discussed above, required for invention IV.

Invention III has a separate utility, usable in an information exchange system including user terminals connected via a plurality of networks, enabling communication between the terminals, for transmitting and receiving messages to/from terminals on a real-time basis to an area independent of a display area for each network, operated concurrently with the first unit, lacking the following features: (i) message acquiring means for acquiring messages transmitted and received to/from the plurality of networks; and (ii) message displaying means for displaying, on a time series basis, the messages acquired independent of the message display area of each of the plurality of networks, **required for invention I; (b) through (c) features discussed above, required for invention II;**

2. Because these inventions are distinct for the reasons given above and because the search required for each group is different and not co-extensive for examination purpose because these groups would require different searches on PTO's classification class and subclass e.g. a) the Group I search (1-3) would require use of search classified in Class 709, subclasses 206, (which would not required for the Groups II-IV); b) the Group II search (claims 4-5) would require use of search Class 455, subclasses 412 (which would not be required for the Groups I, and III-IV), c) the Group III search (claims 6-8,10) would require use of search Class 709, subclasses 227 (which would not be required for the Groups I-II and IV), and d) the Group IV search (claims 9, 11-12) would require use of search Class 379, subclasses 93.01 (which would not be required for the Groups I-III), therefore restriction for examination purposes as indicated is proper.

3. Restriction is required under 35 U.S.C. 121 to one of the above-identified patentably distinct groups of designs. A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is

traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held non-responsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions, which are directed to the non-elected.

4. Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

5. In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Prieto, B.** whose telephone number is **(703) 305-0750**. The Examiner can normally be reached on Monday-Friday from 6:30 to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, **Mark H. Rinehart** can be reached on **(703) 305-4815**. The fax phone number for the organization where this application or proceeding is assigned is **(703) 308-6606**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 305-3800/4700**.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for Official communications intended for entry)

Or:

(703) 746-7240 (for Non-Official or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Fourth Floor (Receptionist), further ensuring that a receipt is provided
stamped "TC 2100".



B. Prieto

Patent Examiner

February 8, 2002

MEHMET B. GECKIL
PRIMARY EXAMINER

